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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2771-514 RCE (7487)
CONF. No. 1697

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on August 25, 2006Signature Ajay PathakTyped or printed name AJAY PATHAK

Application Number

10/022,298

Filed

12/18/01

First Named Inventor

DONATUCCI, et al.

Art Unit

1763

Examiner

BUEKER, Richard

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Sheets 1-5

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 38,266☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Ajay Pathak
SignatureAjay Pathak
Typed or printed name(919) 419-9350
Telephone numberAugust 25, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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10-28-06

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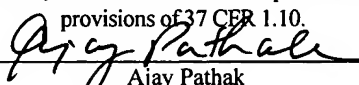


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:)	Docket No.:	2771-514-RCE
)		
Applicants:)	Conf. No.:	1697
DONATUCCI, Matthew B., et)		
al.)		
Application No.:)	Art Unit:	1763
10/022,298)		
Date Filed:)	Examiner:	Richard R. Bueker
December 18, 2001)		
Title:)	Customer No.:	
VAPORIZER/ DELIVERY)		
VESSEL FOR)		
VOLATILE/THERMALLY)		
SENSITIVE SOLID AND)		
LIQUID COMPOUNDS)		25559

EXPRESS MAIL CERTIFICATE

I hereby certify that I am mailing the attached documents to the Commissioner for Patents on the date specified, in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 and Express Mailed under the provisions of 37 CFR 1.10.


Ajay Pathak

August 25, 2006
Date

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NOTICE OF APPEAL AND PRE-APPEAL BRIEF REQUEST IN U.S. PATENT APPLICATION NO. 10/022,298

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The enclosed Notice of Appeal (Form PTO/SB/31) for the above-identified U.S. patent application is being submitted concurrently with a request for one (1) month extension of time.

The enclosed Credit Card Form authorizes payment in the amount of **\$620.00**, which covers the **\$120.00** extension fee specified under 37 CFR §1.17 (a)(3) and the **\$500.00** fee specified under 37 CFR §1.17(b) for the filing of the Notice of Appeal. This Notice of Appeal is also being filed with a Pre-Appeal Brief Request for Review (Form PTO/SB/33).

Respectfully submitted,

Date: August 25, 2016


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Enclosures:

Credit Card Form [1 pg.]
Notice of Appeal [1 pg.]
Attached Sheets [5 pg.]
Pre-Appeal Brief Request [1 pg.]

The USPTO is hereby authorized to charge any deficiency or credit any overpayment of fees properly payable for this document to Deposit Account No. 083284



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:

Applicants: **DONATUCCI, Matthew B., et al.**

Application No.: **10/022,298**

Date Filed: **December 18, 2001**

Title: **VAPORIZER/ DELIVERY
VESSEL FOR
VOLATILE/THERMALLY
SENSITIVE SOLID AND
LIQUID COMPOUNDS**

) Docket No.: **2771-514 RCE (7487)**

) Conf. No.: **1697**

) Art Unit: **1763**

) Examiner: **Richard R. Bueker**

) Customer No.:

25559

**ATTACHED SHEETS ACCOMPANYING FORM PTO/SB/33 (PROVIDING REASONS
IN SUPPORT OF "PRE-APPEAL BRIEF REQUEST FOR REVIEW")**

1. The Response to the May 18, 2006 Final Office Action in U.S. Patent Application No. 10/022,298 filed via facsimile on July 18, 2006 is incorporated herein by reference in its entirety.
2. Claims 1-28 are pending. Claim 5 has been allowed. Claims 15-24 have been withdrawn.
3. The remaining examined claims 1-4, 6-14, and 25-28 are rejected under 35 USC §103(a) for the reasons noted in the Final Office Action mailed May 18, 2006.
4. Applicants' rejected claim 1 is reproduced below (with emphasis added where appropriate) for convenience:

1. A vaporizer comprising:

a thermally conductive block comprising a top surface and bottom surface and a multiplicity of non-moving elongated wells formed therein for placement of a vapor source material, the multiplicity of elongated wells communicatively connected to an interior space within the thermally conductive block for accumulation of vapor, wherein each elongated well consists of a closed end and single opening that is in fluid communication with the interior space, and wherein each elongated well is vertically positioned relative to the top and bottom surface of the conductive block, the thermally conductive block having an interior volume that comprises (i) said interior space and (ii) an internal volume of said multiplicity of elongated wells, wherein the internal volume of said multiplicity of said wells is from about 1/3 to about 1/2 of the interior volume;

a heating device for applying heat to the multiplicity of the elongated wells within the thermally conductive block;

a removable sealing lid positioned on the top of the thermally conductive block for sealing the thermally conductive block to form a closed vessel and removable for ease of filling the elongated wells; and

an openable and closable outlet for discharge of vapor formed in the vaporizer communicatively connected to the removable sealing lid and the interior space. [(Emphasis added.)]

5. Regarding emphasized relevant language from rejected claim 1 above, it is noted at the outset that the “thermally conductive block” comprises a top surface, a bottom surface and a multiplicity of non-moving wells. (Emphasis added.)
6. Also, regarding additional emphasized relevant language from rejected claim 1 above, the “sealing lid” is “positioned on top of the thermally conductive block for sealing the thermally conductive block [(i.e., for sealing the thermally conductive block itself; not for sealing the entire vaporizer with the “sealing lid”)] to form a closed vessel” with the “sealing lid” and “the thermally conductive block” itself. (Emphasis added.)
7. The crux of the Final Office Action rejections under 35 USC §103(a), is that the primary reference “Barr” (U.S. Patent No. 2,447,789) arguably discloses a “plate” 15, which may be varied to provide the “sealing lid” feature of Applicants’ rejected claim 1. It is the Examiner’s contention that language appearing in Barr (at col. 3, lines 20-29) teaches one of ordinary skill that the plate 15 of Fig. 1 of Barr may be varied to provide a “sealing lid,” as recited in Applicants’ rejected claim 1. See Interview Summary of August 16, 2006 mailed on August 18, 2006 at page 3 (last page). Respectfully, the Examiner’s assertions and conclusions cannot stand for the reasons already presented and now reiterated once again.
8. For convenience, the relevant language (col. 3, lines 20-29) and Fig. 1-2 of the Barr reference are reproduced below:

FIG. 1

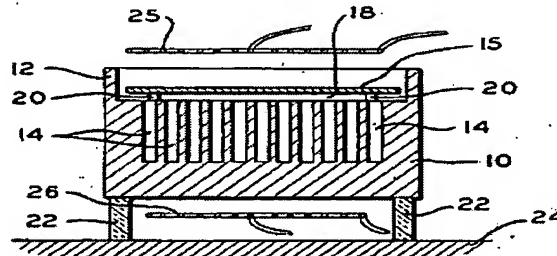
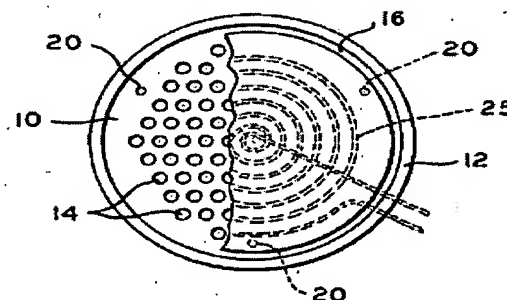


FIG. 2



It will be apparent that the above-described construction is subject to considerable variation without departing from the scope of the invention. For example, it has been pointed out that the screening means other than plate 15 may be used and that the mounting for said screening means may be varied in many ways. The size of annular space 16 may readily be altered by

changing the size or shape of plate 15 to limit the passage from the crucible of particles greater than any predetermined size. [(Barr at col. 3, lines 20-29; emphasis added)].

9. First, plate 15 is admittedly referenced in Barr as a non-sealing porous member by use of the language “screening means other than plate 15.” Second, clearly, the import or meaning of the phrase “changing the size or shape of plate 15 to limit passage . . . of particles greater than any predetermined size” requires that particles below the limit be allowed to pass. Thus, “a sealing lid” to form a completely “closed vessel” with “the thermally conductive block” is not taught, sought, suggested or contemplated by the Barr disclosure. Otherwise, the above-quoted language “to limit . . . passage . . . of particles greater than any predetermined size” would be meaningless. Certainly, the Court of Appeals for the Federal Circuit (“Federal Circuit”) has made it abundantly clear that an Examiner is not at liberty to ignore the import of language one does not like as reiterated in paragraphs 15-16 below. The Examiner does not have leeway to ignore relevant portions of the Barr reference expressly teaching away from Applicants’ claimed invention.

10. The Barr reference discloses (at col. 2, lines 22-30) that the radius of plate 15 may be varied so long as there is a space/gap maintained, referred to as “space 18” and “space 16” in reference to Figs. 1 and 2 thereof. The relevant language appearing (at col. 2, lines 22-30 of Barr) is reproduced below.

As shown in the drawings, the radius of the plate 15 is preferably just sufficiently smaller than the inner radius of flange 12 to leave an annular space 16 (Fig. 2) therebetween. For example, space 16 may be of the order of 0.10 inch in width. Plate 15 may be mounted in any suitable way within flange 12 but above the top of body member 10 in order to leave a space 18 therebetween, [(col. 2, lines 22-30; emphasis added)].

The essence of the foregoing language is that it is appropriate to vary plate 15 with the proviso that “plate 15 may be mounted in any suitable way within the flange 12[,] but above the top of body number 10 in order to leave a space 18 therebetween.” (Emphasis added). The foregoing disclosures and features of Barr unambiguously require that while the radius of plate 15 may be varied, a space 18 (e.g., between plate 15 and body member 10) and space 16 (e.g., between flange 12 and the body member 10) must be maintained.

11. Additionally, as depicted in Figs. 1 and 2 of Barr, studs 20 prevent formation of a “sealing lid” with body member 10 to form a “closed vessel.” Such structure is consistent with the described requirement of space 18 and space 16.

12. On August 16, 2006, during a telephone conference with Examiner Bueker, these same points were reiterated. However, the Examiner insisted that the language in Barr is merely directed to a preferred embodiment of the Barr disclosure and, therefore, the clear “teachings away” of Barr are rightly ignored. In that regard, it was pointed out to the Examiner that there is considerable case law from the Federal Circuit requiring the Examiner to consider the entire applied reference as a whole. See paragraphs 15 and 16 below. However, the Examiner remained unpersuaded and adamantly adhered to his position. Accordingly, the Examiner refused to concede the weakness of the rejections of record under 35 USC §103(a) relying on Barr.

13. During the same telephone conference, the Examiner then reiterated his reliance upon Greer (U.S. Pat. No. 5,104,695) arguably disclosing a “sealing lid” on a “thermally conductive block” as recited in Applicants’ rejected claim. However, attention is directed to Fig. 2 of Greer wherein a “screen mesh” 24 is depicted to form a “sealing lid.” Reviewing Fig. 2 and the remainder of the Greer reference, it is clear that that a “screen mesh” 24 cannot form a “closed vessel” with a “thermally conductive block” comprising a top surface, a bottom surface and a multiplicity of non-moving elongated wells, at least simply because the “screen mesh” 24 itself is “non-sealing” member by virtue of it being a porous *i.e.*, a screen mesh. Certainly, there is no disclosure in Greer of a “thermally conductive block” containing a multiplicity of non-moving elongated wells and forming a “closed vessel” with a “sealing lid” as recited in rejected claim 1.

14. The Examiner then went on to reiterate that the entire apparatus of Greer is sealed. That simply does not address the express language of Applicants’ rejected claim 1 requiring that the “sealing lid” together with the “thermally conductive block” must be able to “form a closed vessel.” There is no such disclosure in Greer. Certainly, the screen mesh 24 (sometimes referenced as 24a or 34) and crucible or cup 18 of Greer do not “form a closed vessel.” It was also discussed that the Stall reference (U.S. Pat. No. 5,336,324) is just as, if not more, deficient than are the Barr and Greer references. Even so, the Examiner remained adamant in maintaining the rejections under 35 USC § 103.

15. It was further reiterated by Applicants that neither Stall nor Holloway (U.S. Pat. No. 3,647,197), the other cited references, disclose the “sealing lid” feature recited in Applicants’ rejected claim requiring that it is able to form together with the “thermally conductive block” a “closed vessel.” Once again, the Examiner simply would not accept the logic of the foregoing arguments, nor accept the controlling Federal Circuit case law that the Examiner is required to consider an applied reference “as a whole” and not just rely on the parts the Examiner likes.

16. Unambiguously, the Examiner is required to consider each applied reference as a whole as noted in *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082 (Fed Cir. 1985). With regard to the obviousness inquiry under 35 USC § 103(Federal Circuit) has made it clear that the cited art must be considered as a whole:

What happened here occurred in *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1550, 1552, 221 U.S.P.Q. at 311, 312, where this court stated:

In its consideration of the prior art, however, the district court erred . . . in considering the claims in less than their entirety . . . and [**33] in considering the references in less than their entirety, i.e., in disregarding disclosures in the references that diverge from and teach away from the invention at hand. . . . The result is that the claims were used as a frame, and individual naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention.

Three fundamental errors resulted from a disregard of the decisional parameters governing the proper evaluation of prior art. The first, as above indicated, was the picking and choosing of “teeth”, “ledges”, and “hinges” either absent from the prior art references or there disclosed in entirely distinct [**34] form, characteristics, and relationships. It must be remembered that the

Examiner is required to consider references in their entireties, i.e., including those portions that would argue against obviousness. The statute governing the obvious/non-obvious determination in light of the prior art, 35 U.S.C. § 103, is as applicable to courts as it is to Examiners. Courts are not, of course, bound by the Examiner's determination, but a court's route to a contrary determination is governed by the same statute, and must not be based on a superficial review of the prior art like that here employed. [(*Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1094 (Fed. Cir. 1985); emphasis added.)]

The Federal Circuit once more reiterated the controlling case law that the cited art must be considered as a whole. In other words, the prior art's teachings away from the claimed invention must also be considered. That point was noted by the Federal Circuit as quoted below:

A § 103 determination involves fact and law. There may be these facts: what a prior art patent as a whole discloses; what it in fact disclosed to workers in the art . . . [(*Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987); underline and bold emphasis added.)]

* * *

(2) Legal Standards

Clarity in the law requires universal application of the same legal standards to fact-finding functions performed en route to final § 103 conclusions.

Among legal standards for determining scope and content of the prior art, for example, are: a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. (BNA) 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851, 83 L. Ed. 2d 107, 105 S. Ct. 172 (1984); . . . [(*Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987); underlining and bold emphasis added.)]

Thus, per the Federal Circuit, the Examiner must consider cited reference as a "whole" for all that it teaches and also teaches away.

17. In view of the foregoing, Applicants' claimed invention is patentable over the applied references already noted in the Response to the May 18, 2006 Final Office Action. Allowance of all pending claims 1-28, including the withdrawn claims 15-24, is requested. Also, rejoinder of withdrawn claims 15-24 under MPEP § 821.04 is also requested.

Date: August 25, 2006

Respectfully submitted,

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Attorney File No.: 2771-514 RCE (7487)

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